

Applicants also provisionally elect, with traverse, the species Iodosulfuron-methyl SMe₃, compound No. 1, Table 4 on page 28 of the specification. Any fee occasioned by this paper may be charged, or overpayment credited to, Deposit Account No. 50-0320.

REMARKS

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks made herein, which place the application in condition for allowance.

The March 7, 2003 Office Action required an election under 35 U.S.C. §§ 121 and 372 from:

Group I: Claims 1-17, drawn to sulfonylurea compounds, compositions comprising them, and their use as herbicides or plant growth regulators; and

Group II: Claim 18, drawn to the use of phosphonium or sulfonium salts of polyalkoxylated hydrocarbyl compounds of formula XVIII.

The March 7, 2003 Office Action also required an election of a species, specifically a single sulfonylurea compound.

Applicants provisionally elect, for further prosecution in this application, the invention of Group I, claims 1-17, drawn to sulfonylurea compounds, compositions comprising them, and their use as herbicides or plant growth regulators. This election is made *with traverse* and is made without prejudice to Applicants' right to file divisional applications directed to the non-elected subject matter. It is respectfully requested that the restriction requirement be favorably reconsidered and withdrawn.

Applicants also provisionally elect the species Iodosulfuron-methyl SMe₃, compound No. 1, Table 4 on page 28 of the specification. This election is also made *with traverse* as the species are each related to one another and directed to the same inventive concept, i.e., capable of being simultaneously searched. It is Applicants' understanding that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all of the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.

Applicants respectfully urge that the Restriction Requirement does not establish that searching all the inventions would constitute an undue burden to the Patent Office. Moreover, Applicants urge that the Restriction Requirement is contrary to public policy. Accordingly, Applicants submit that the Restriction Requirement is improper and should be withdrawn or at least modified.

The M.P.E.P. lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. M.P.E.P. § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The M.P.E.P. directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.*

Applicants urge that the Restriction Requirement does not meet the second of these criteria as the search for all of the groups overlaps. Further still, the present claims represent a web of knowledge and continuity of effort that merit examination in a single application. And unity of invention exists, further negating restriction. More specifically, Applicants disagree

with the allegation that the two Groups lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

It is respectfully urged, therefore, that restricting the claims in the manner suggested in the Restriction Requirement constitutes an undue burden to Applicants as well as to the public. The cost of prosecuting and maintaining so many patents is unreasonable in view of the fact that the two groups are so closely related. Further, the public is inconvenienced as they will not know whether or not Applicants will file a divisional application to the remaining subject matter. Thus, the public will not know if they can practice the remaining invention without infringing future patent applications.

With regard to the election of species requirement, the Examiner is respectfully requested to review M.P.E.P. § 808.01(a) which states that “where there is no disclosure of relationship between species (*see* M.P.E.P. §806.04 (b)), they are independent inventions and election of one invention” is required (July 1998). In view of M.P.E.P. §803, however, when the generic claim includes sufficiently few species that a search and examination of all the species at one time would not impose a serious burden on the examiner, then a requirement for election is inappropriate.

Applying the law to the instant facts, the election of species requirement is not appropriate. The species of sulfonylureas are not too great in number and, thus, can be searched without serious burden. Further, Applicants disagree with the allegation that the species lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. Therefore, the request for election should be withdrawn.

In view of the above, reconsideration and withdrawal of the requirement for

restriction and election of species are respectfully requested.

CONCLUSION

In view of the remarks herewith, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance, or an interview at a very early date with a view to placing the application in condition for allowance, are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date.

Respectfully submitted,

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